

## REMARKS

The courtesy extended by Examiner Gilliam to applicant's attorney, Robert G. Mukai, during the telephonic discussion on May 17, 2005 is greatly appreciated. During the discussion, applicant's attorney explained certain aspects of the invention and set forth the reasons why the cited prior art did not disclose or suggest the invention as defined in proposed amended claim 1. In this respect, it was explained to Examiner Gilliam that while the subject matter of claim 3 would be incorporated into claim 1, the terminology would be revised so that the subject matter is more clear. Finally, it was noted that the citation form that accompanied the Official Action dated February 17, 2005 inadvertently did not include the initials on the first cited document and it was requested that such document be acknowledged in the next Official Action. Examiner Gilliam stated that she understood applicant's arguments and that she would reconsider the rejections after conducting a further search of the art.

By the present response, minor typographical errors in the specification have been corrected and claim 1 has been amended consistent with the aforementioned discussion with Examiner Gilliam. More specifically, claim 1 has been amended to include the subject matter of claim 3, but using slightly different language, and claim 3 has been canceled without prejudice or disclaimer. The modified language has been used throughout the remaining dependent claims, other editorial revisions have been implemented and the dependency of certain claims has been revised to accommodate the amendments made in claim 1.

Claim 1 currently defines a method of making a lithographic printing plate from a heat-sensitive pre-sensitized plate of a positive working mode for lithographic printing. The method comprises the steps of exposing the heat-sensitive pre-

sensitized plate to light, and developing the plate using an alkaline developing solution comprising at least one compound having three or more ethylene oxide-terminal groups in the molecule thereof, wherein the pre-sensitized plate comprises a substrate, a lower layer which comprises a water-insoluble and alkali-soluble resin, and an upper heat-sensitive layer which comprises a water-insoluble and alkali-soluble resin and an infrared absorption dye and exhibits an elevated solubility with respect to alkaline aqueous solutions when heated. The lower layer and the upper heat-sensitive layer are located on the substrate in the stated order.

The specification provides additional insight as to the meaning of the compound having three or more ethylene oxide-terminal groups in the molecule thereof. In particular, the Examiner's attention is respectfully directed to the discussion starting at the bottom of page 14 and particularly to the examples set forth on page 16 of the specification. As can be seen from illustrative compounds (A) through (F), each of the compounds has at least three terminal groups which are formed from ethylene oxide chains.

By following the teachings of the present invention, one can obtain effective development of the exposed plate so that non-image areas are sufficiently developed without providing a residue of the lower layer on the non-image areas. Such advantageous results can be seen from the examples set forth in Tables 2 and 3 on pages 77-78, the results of which are reported in Tables 5 and 6 on pages 82-83 and Tables 8 and 9 on pages 85-86. In this respect, it will be noted that the results are superior to those which can be obtained by using polyethylene glycol having a molecular weight of 1,000 or 1,500 in Comparative Examples 2, 3, 5 and 6.

With a proper understanding of the present invention and the substantial advantages which may be obtained therefrom, applicant respectfully submits that the

documents cited in the Official Action cannot be used to reject any of the claims now of record. In particular, Oda, U.S. Patent Application Publication No. 2004/0131966 relates to a thermosensitive lithographic printing plate comprising a hydrophilic support, a lower layer comprising a water-insoluble and alkali-soluble resin and an upper thermosensitive layer comprising a water-insoluble and alkali-soluble resin and an infrared absorbing dye, whose dissolution in an alkaline aqueous solution increases upon exposure. The surface of the upper thermosensitive layer has protrusions caused by non-uniformity of thickness of the upper thermosensitive layer in a defined proportion or the upper thermosensitive layer comprises at least two alkali-soluble resins having a different dissolution speed and cause phase separation from each other. The Examiner has relied on the discussion provided in paragraph [0173] with respect to the alkaline development processing solution and has particularly referred to the description therein of a nonionic surfactant which contains an ethylene oxide chain or propylene oxide chain with the nonionic surfactant containing an ethylene oxide chain being preferred.

As noted above, the claims of record include an alkaline developing solution comprising at least one compound having three or more ethylene oxide-terminal groups in the molecule thereof. Oda does not in any way meet this specific recitation set forth in the claims. The nonionic surfactant in paragraph [0173] simply refers to a non-ionic surfactant that contains an ethylene oxide chain and clearly does not recognize the importance of having at least three ethylene oxide-terminal groups in the molecule as illustrated in the specification and as claimed. Therefore, based on

the claims and evidence of record, it is without question that Oda cannot be properly relied on to reject any aspect of the presently-claimed invention.<sup>1</sup>

As an additional point of consideration, while applicants maintain that the claims of record are patentable over Oda for the reasons provided above, applicant has nonetheless provided herewith a Statement of Common Ownership so that Oda cannot be relied on as "prior art" under 35 U.S.C. § 103(a).

Since all matters raised in the Official Action are believed to be fully met by the instant response, applicants respectfully request reconsideration and allowance of the present application.

Should the Examiner wish to discuss any aspect of the present application, she is invited to contact the undersigned attorney at the number provided below.

Respectfully submitted,

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<sup>1</sup> Although applicants do not necessarily agree with the rationale of the rejection of claims 1-2 and 4-14 based on Verschueren et al., U.S. Patent No. 6,340,815, since the subject matter of claim 3 has been included into claim 1 and claim 3 was not included in this rejection, the rejection based on Verschueren et al. is believed to be moot.